

REMARKS

Claims 1-27 are pending in the application.

Claims 1-27 stand rejected.

Claims 2 and 4 have been amended to correct a typographical error and to clarify the claims.

Formal Matters

Applicants appreciate the Examiner finding the drawings acceptable as filed.

Rejection of Claims under 35 U.S.C. § 112

Claims 1 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and distinctly claim the subject matter for which the Applicants regard as the invention.

Applicants respectfully traverse this rejection because claims 1 and 7 use the terms “subsequent” and “prior” consistently. The terms are used with respect to two different aspects altogether. Specifically, claim 1 recites the action of “transmitting data ... to a memory for storage.” This action occurs twice in claim 1, the second time the action occurs follows, or is subsequent to, the first time the action occurs. Alternatively, claim 7 refers to data that was stored in a memory device. The data is used for generating a “data quantity value.” Data quantity values represent the data that has been stored in the memory device. In claim 7, a second data quantity value is generated from data that was stored in the memory device at a different point in time than the storing point of data that was used to generate the first data quantity value. Specifically, claim 7 states that the second data quantity value is generated from

data that was stored at a point prior to the point when the data was stored that was used to generate the first data quantity.

In other words, the term “subsequent” of claim 1 relates to different times for the action of transmitting data, while the term “prior” of claim 7 relates to the times that data was stored. Thus, Applicants respectfully submit that the terms “subsequent” and “prior” of claims 1 and 7 relate to different claim terms and the term ordering is consistent in the claims thereby supporting Applicants’ assertion that the claims are clear and unambiguous. Therefore, Applicants urge the Examiner to withdraw the 112 rejection of claims 1 and 7.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-3, 11, 12, 18-20, 25 and 26 stand rejected under 35 U.S.C. § 102(e), as being anticipated by Holden et al., U.S. Patent No. 6,147,997 (Holden). Applicants respectfully traverse this rejection as the claims are not anticipated by Holden.

Applicants’ claim 1 recites a method for

a transmitting device transmitting data at a first non-zero rate *to a memory for storage* therein during a first period of time;
the transmitting device transmitting data at a second non-zero rate *to the memory for storage* therein during a second period of time;
wherein the second period of time is subsequent to the first period of time, and;
wherein the second non-zero rate is greater than or less than the first non-zero rate.

The Office Action cites Holden, col. 2, lines 30-67 in an attempt to show Applicants’ claim 1. Holden states

The present invention provides systems and methods for utilizing an UTOPIA level 2 interface over a backplane to connect

up to 31 Physical layer devices to one ATM layer device in a logically partitioned manner utilizing full bandwidth.

An UTOPIA interface over a backplane allows the Physical layer devices placed on several boards to connect with other boards via a backplane. An UTOPIA interface over a backplane reproduces standards based behavior on the far end of the backplane with respect to the ATM layer. Hence, the Physical layer devices operate using normal 50 MHz UTOPIA level 2 defined handshakes. This requires the ATM layer device to accept the cell available handshakes at a time later than it would otherwise. Additional hardware is placed between the ATM layer devices and Physical layer devices in the form of demultiplexers and multiplexers.

The method of the present invention includes the steps of receiving communications data on a first terminal at a first transfer rate, reducing the rate of transfer of the communications data from the first transfer rate to a second transfer rate, transmitting the communications data over a backplane at the second transfer rate, receiving the communications data on a second terminal, and increasing the rate of transfer of the communications data from the second transfer rate to the first transfer rate. The first transfer rate is greater than the second transfer rate. The method also includes the steps of accepting the cell available handshake later than it would otherwise to reproduce the standardized timing at the PH1 interface which is on the other side of the backplane and the means to configure such operation.

The device of the present invention includes a first demultiplexer coupled to an ATM layer device, a first multiplexer coupled to the first demultiplexer using a UTOPIA level 2 interface over the backplane and a plurality of physical layer devices, a second multiplexer coupled to the ATM layer device, and a second demultiplexer coupled to the second multiplexer using the UTOPIA level 2 interface over the backplane and the plurality of physical layer devices.

Holden, col. 2, lines 29-67 (emphasis added)

In general, the cited sections of Holden fail to teach or disclose two separate occurrences of “a transmitting device transmitting data ... to a memory for storage.” As recited in Applicants’ independent claims 1 and 18, each of these transmissions is at a different time and at

a different non-zero rate. In the sections of Holden cited in the Office Action, a first terminal receives communications at a first transfer rate and then a second terminal receives communications at a second transfer rate (see italicized paragraph). The cited sections of Holden do not teach or disclose the same terminal receiving communications at different transfer rates much less teach or disclose a transmitting device that transmits the communications to the same terminal at two different non-zero rates as claimed by Applicants. Specifically, the cited sections of Holden fail to disclose a transmitting device transmitting data at a first non-zero rate to a memory storage, and then having the same transmitting device later transmitting data to the memory storage at a second non-zero rate.

Regarding dependent claims 11-12 and 25-26, which depend from and contain the limitations of independent base claims 10 and 24, respectively, as conceded in the Office Action regarding the independent base claims 10 and 24, Holden fails to “indicate a first means for generating and transmitting a rate control signal instructing the transmitting device to stop transmitting data to the memory device at a first non-zero rate and to begin transmitting data to the memory device at a second non-zero rate” (Office Action, page 12, second paragraph). Thus, the Office Action has conceded that dependent claims 11-12 and 25-26 are not anticipated by Holden and Applicants respectfully request withdrawal of the 102 rejection of these claims.

In view of the above comments, Applicants urge the Examiner to withdraw the 35 U.S.C. § 102(e) rejection of independent claims 1 and 18 as being anticipated by Holden. As dependent claims 2-3, and 19-20 add limitations to otherwise allowable base claims, Applicants respectfully request withdrawal of the 102 rejection of these claims as well.

Rejection of Claims under 35 U.S.C. § 103

Independent claims 10 and 24 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Holden in view of Shinohara, U.S. Patent No. 6,122,251 (Shinohara) in further view of Ito et al., U.S. Patent No. 5,539,747 (Ito).

Applicants' independent claim 10 recites an apparatus comprising:

- a memory device configured to receive data from a transmitting device for storage therein;
- a circuit configured to generate and transmit a rate control signal instructing the transmitting device to stop transmitting data to the memory device at a first non-zero rate and to begin transmitting data to the memory device at a second non-zero rate;
- wherein the second non-zero rate is greater than or less than the first non-zero rate

As shown herein with respect to the 102 rejection, in the Office Action, the Examiner admits that Holden does not disclose the rate control signal as claimed in Applicants' independent claims 10 and 24. Col. 7 and col. 8 of Shinohara is cited in an attempt to overcome this deficiency. However, Shinohara, cols. 7-8 does not teach or disclose a rate control signal for "instructing the transmitting device to stop transmitting data to the memory device at a first non-zero rate and to begin transmitting data to the memory device at a second non-zero rate" as required by claim 10. At best, the cited sections of Shinohara teach a stop signal which supports two different rates, but not a first non-zero rate and a second non-zero rate as claimed. Further, although Ito is also cited as a basis for the 103 rejection, no argument is made in the Office Action regarding Ito. As independent claim 24 contains generally the same limitations as independent claim 10, Applicants respectfully submit that all elements of both Applicants' claims 10 and 24 are not shown by the combination.

In order for a claim to be rendered invalid under 35 U.S.C. § 103(a), the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. See MPEP2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

In addition to failing to show all elements of the claims by the cited references, the Office Action does not satisfy the burden of factually supporting the alleged motivation to combine the references. The Examiner's duty may not be satisfied by engaging impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" See *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Applicants respectfully submit that the particular parts of the cited references relied upon by the Examiner and the pertinence of each reference has not been clearly explained, especially with regard to the motivation to combine the references. Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required.

Regardless, even if Shinohara were to be combined with Holden as suggested by the Examiner, the combination fails to disclose two separate occurrences of "a transmitting device transmitting data ... to a memory for storage." As discussed herein, combining Shinohara cols. 7-8 with Holden does not add modifications to the Holden system that would meet the claimed requirements of Applicants independent claims. Further, the Examiner fails to describe any

reason for combining Ito with the Holden/Shinohara combination which supports Applicants' assertion that the combinations made in the Office Action are based on hindsight reference to Applicants' claims rather than the references themselves.

For these reasons, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of independent claims 10 and 24 as being unpatentable over Holden in view of Shinohara in further view of Ito.

Dependent claims 5-9, 13, 14-17, 22-23, and 27 also stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Holden in view of Shinohara in further view of Ito. As dependent claims 5-9, 13, 14-17, 22-23, and 27 add further limitations to otherwise allowable base claims, Applicants traverse this rejection for at least the same reasons given above and request the Examiner to withdraw the rejection of claims 5-9, 13, 14-17, 22-23, and 27.

Dependent claims 4 and 21 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over Holden in view of Shinohara. Applicants respectfully traverse the rejection of claims 4 and 21.

Regarding the respective independent base claims 1 and 18 of dependent claims 4 and 21, Holden fails to teach or disclose two separate occurrences of "a transmitting device transmitting data ... to a memory for storage." Regarding the limitation of a rate control signal added by dependent claims 4 and 21, the Office Action cites Shinohara, cols. 7-8 for support of the rejection. However, as stated above, Shinohara, cols. 7-8 does not teach or disclose a rate control signal to "instruct the transmitting device to stop transmitting data at the first non-zero rate and start transmitting data at the second non-zero rate" as required by claim 4 and generally by claim 21.

For these reasons, Applicants respectfully request the Examiner to withdraw the 35 U.S.C. § 103(a) rejection of dependent claims 4 and 21 as being unpatentable over Holden in view of Shinohara.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5089.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 1, 2005.


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11/1/05
Date of Signature

Respectfully submitted,



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